

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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|------------------------|---|------------------------------|
| In re Application of: |) | |
| Clifton Lind et al. |) | |
| |) | Group Art Unit: 3714 |
| Serial No.: 10/643,189 |) | |
| |) | |
| Filed: August 18, 2003 |) | Examiner: Binh An Duc Nguyen |
| |) | |
| FOR: DYNAMICALLY |) | |
| CONFIGURABLE GAMING |) | Confirmation No.: 3668 |
| <u>SYSTEM</u> |) | |

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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPELLANTS' REPLY BRIEF

This Reply Brief is filed pursuant to 37 C.F.R. §41.41 in response to the Examiner's
Answer (the "Answer") mailed June 25, 2008, regarding the above-identified application.
Appellants submit this Reply Brief within the two-month period following the mailing of the
Answer.

I. STATUS OF THE CLAIMS

1. Claims 32, 33, 39, 40, and 42 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0166940 A1 to Rothschild ("Rothschild" or "Rothschild reference")

2. Claims 25-31, 34-38, and 41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rothschild in view of U.S. Patent No. 5,923,252 to Sizer et al. ("Sizer" or the "Sizer patent").

The Appellants maintain all of the arguments set out in the Appellants' Appeal Brief filed April 1, 2008 in the present case, and present the following additional arguments in view of the Answer.

II. ARGUMENT

A. THE ANSWER FAILS TO SHOW THAT THE ROTHSCHILD REFERENCE DISCLOSES EACH ELEMENT REQUIRED BY CLAIMS 32, 33, 39, 40, AND 42, AND THUS FAILS TO SHOW THAT THESE CLAIMS ARE ANTICIPATED BY THE ROTHSCHILD REFERENCE.

Claim 32

Element (b) of claim 32 requires:

a player data collection arrangement for detecting that a person has been assigned to the hotel room in which the gaming machine is located and for storing player preference information for the person assigned to the hotel room.

This element unambiguously requires a device that functions to detect that a person has been assigned to a hotel room in which a gaming machine is located. The Answer at page 8 refers to

1 paragraphs 31-33 of Rothschild as disclosing the element required at element (b) of claim 32. It
2 is clear from a review of paragraphs 31-33 of Rothschild (reproduced in the Answer at pages 8-9)
3 that they simply do not disclose any device that functions to detect that a person has been
4 assigned to a hotel room in which a gaming machine is located. The only reference to a hotel in
5 the cited paragraphs is a reference to a "casino/hotel database 40c." The mere reference to a
6 "casino/hotel database" in paragraph 32 of Rothschild and the reference to a "computing device
7 14" that may be used in a hotel room (Rothschild at paragraph 22) is a far cry from disclosing or
8 even suggesting a device capable of detecting that a person has been assigned to a hotel room in
9 which a gaming machine is located. The portions of the Rothschild reference that the Answer
10 cites for disclosing the requirements of element (b) of claim 32 simply do not disclose those
11 requirements.

12 The references to Rothschild listed in the Answer as showing the requirements of
13 elements (c) and (d) are also deficient. The Answer cites paragraphs 22, 24, and 30 of
14 Rothschild (reproduced at pages 10 through 11 of the Answer) as disclosing the limitation set out
15 at element (c) of claim 32. However, nothing in the cited paragraphs discloses or suggests "a
16 system configuration arrangement for producing a system configuration command based on the
17 player preference information for the person assigned to the hotel room" as required at element
18 (c) of claim 32. The Answer cites paragraph 31 of the Rothschild reference (reproduced at pages
19 11-12 of the Answer) as disclosing the limitation set out at element (d) of claim 32. However,
20 nothing in paragraph 31 of Rothschild discloses or suggests any element "for responding to the
21 system configuration command by communicating presentation switching instructions to the

1 gaming machine, the presentation switching instructions causing the gaming machine to produce
2 a game presentation specified by the presentation switching instructions.” In particular, the fact
3 that a casino's player tracking system stores game preference variables as disclosed in paragraph
4 31 of Rothschild does not lead to the conclusion that this information is used to set up a given
5 gaming machine, and certainly does not lead to the conclusion that the information is used to set
6 up a gaming machine in a hotel room for a player assigned to that hotel room.

7 Because the Rothschild reference does not explicitly or inherently disclose the structure
8 required at any of elements (b), (c), and (d) of claim 32, the Rothschild reference cannot
9 anticipate claim 32. The Appellants therefore respectfully maintain that the anticipation rejection
10 of claim 32 in view of Rothschild is in error and should be reversed along with the anticipation
11 rejection of claim 33 which depends from claim 32.

12 The Appellants note the analysis set out in the Answer at the first full paragraph of page
13 12. Even taking all of the statements regarding the Rothschild reference in this analysis at face
14 value, nothing in the analysis compels the stated conclusion that claim 32 is anticipated by the
15 Rothschild reference. In fact, the statements regarding Rothschild set out in the Answer at the
16 first full paragraph of page 12 are totally divorced from the requirements of claim 32. That is,
17 the analysis does not compare the elements purported to be disclosed in Rothschild with the
18 Appellants' claim language under consideration. Thus the analysis set out in the Answer at the
19 first full paragraph of page 12 is clearly in error.

20 Furthermore, the Appellants believe that the statements at the first full paragraph of page
21 12 of the Answer cannot be taken at face value. In particular, the Appellants find no support in

1 Rothschild for the proposition that “the gaming system of Rothschild allows the player to access
2 the hotel using the tracking card....”
3

4 Claims 39 and 42

5 As discussed in the Appellants Appeal Brief at pages 12-14, claims 39 and 42 are,
6 respectively, method and program product claims requiring limitations corresponding generally
7 to those set out in apparatus form in claim 32. The Answer applies the same disclosure from the
8 Rothschild reference against corresponding elements of claims 39 and 42 as it applies to claim
9 32. Therefore the above comments regarding the analysis in the Answer as to claim 32 applies
10 with equal force to claims 39 and 42. Perhaps most importantly, the mere references to a
11 hotel/casino database 40c and computing devices 14 in Rothschild do not amount to a disclosure
12 of detecting that a player has been assigned to a hotel room in which a gaming machine is located
13 as required at element (a) of claim 39, nor does it amount to a disclosure of system configuration
14 program code executable for retrieving game preference information on a player that has been
15 assigned to a hotel room in which a gaming machine is located as required at element (a) of
16 claim 42.

17 Because the Rothschild reference does not explicitly or inherently disclose all of the
18 elements required in claims 39 and 42, the Rothschild reference cannot anticipate these claims.
19 The Appellants therefore respectfully maintain that the anticipation rejection of claims 39 and 42
20 in view of Rothschild is in error and should be reversed along with the anticipation rejection of
21 claim 40 which depends from claim 39.

1 B. THE ANSWER FAILS TO SHOW THAT THE PROPOSED COMBINATION OF THE
2 ROTHSCHILD REFERENCE AND THE SIZER PATENT INCLUDES EACH
3 ELEMENT SET OUT IN CLAIMS 25-31, 34-38, AND 41.

4 The Answer does not address the errors described in the Appellants' Appeal Brief from
5 page 15, line 13 to page 16, line 2, and from page 16, line 27 to page 17, line 4. Specifically, the
6 Answer does not address the Appellants' position that even combining the marketing message
7 device of Sizer with the gaming system of the Rothschild reference would still not meet the
8 limitations in independent claims 25 and 34 of switching a game presentation at a gaming
9 machine prior to an arrival of the approaching player at the gaming machine. If one were to
10 combine the marketing message device of Sizer with the gaming system disclosed in Rothschild,
11 the resulting system could do no more than display a marketing message to a casino patron who
12 took some action in a particular area to trigger the marketing message (See Sizer at col. 2, line 30
13 to col. 3, line 16 regarding the "determination means" for determining if a marketing message
14 should be delivered). Combining the system disclosed in Rothschild with the marketing message
15 system in the Sizer patent would certainly not result in changing game presentations at a gaming
16 machine. Furthermore, the proposed combination of the system shown in Rothschild and the
17 system shown in the Sizer patent would not suggest changing any display at a gaming machine in
18 any way, including changing a display to show a marketing message. That is, there is no reason
19 apparent in the prior art to provide the Sizer marketing message at a gaming machine rather than
20 a separate device.

21 Not only is there no reason apparent in the prior art to provide the Sizer marketing
22 message at a gaming machine in the system disclosed in Rothschild, but also elements of the

1 Sizer marketing message delivery system suggest that it would not be appropriate to use a
2 gaming machine in the Rothschild system to display the desired marketing message. This is
3 because the Sizer system emphasizes that the patron must take some action which indicates that a
4 marketing message should be delivered. In particular, Sizer discloses that a marketing message
5 should be delivered only if a patron shows an interest in a particular product (See Sizer at col. 15,
6 lines 15-35). If this is applied in the context of a gaming system, the marketing message could
7 interfere with the patron's interest in a given game. For example, a casino patron may linger at an
8 unoccupied gaming machine while they review the attract graphics and pay tables displayed at
9 the gaming machine. Displaying a marketing message rather than the attract graphics and pay
10 tables which already caught the patron's attention would appear to be counterproductive to
11 enticing the patron to play the game.

12 Finally, the Appellants note that the Answer also includes errors regarding the
13 interpretation of the Sizer patent. In particular, the Answer at lines 11-16 of page 15 cites Sizer
14 at col. 7, line 33 to col. 8, line 49; col. 15, lines 16-35; and col. 16, lines 14-32 for the
15 proposition that product advertising messages are coordinated upon an arrival of the "player"
16 along an aisle. First, Sizer does not disclose "players." Furthermore, the cited sections of Sizer
17 do not disclose coordinating advertising messages upon an arrival of any customer at a given
18 location.

19 For all of these reasons the Appellants respectfully submit that claims 25 and 34 are not
20 obvious in view of the proposed combination of Rothschild and Sizer, and thus that the rejections

of these claims and their respective dependent claims, claims 26-31 and claims 35-38, and 41, are
in error and should be reversed.

II. CONCLUSION

For all of these reasons and for the reasons set out in the Appellants' Brief, the Appellants
submit that the rejection of claims 25-42 is in error, and submit that the claims are entitled to
allowance. The Appellants therefore respectfully request that the Board reverse the decision of
the Examiner rejecting these claims.

Respectfully submitted,

The Culbertson Group, P.C.

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